

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Appl. No. : 09/761,670

Confirmation No: 5377

Applicant : Jeff S. Eder

Filed : January 18, 2001

Art Unit : 3695

Examiner : Siegfried Chencinski

Docket No. : AR - 16

Customer No. : 53787

SUPPLEMENTAL AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Remarks are reflected in the narrative that begins on page 2 of this paper

PLEASE NOTE: THE INSTANT SUPPLEMENTAL AMENDMENT WAS ALSO SUBMITTED
TO THE IFW OF 09/761,670 ON 8/11/2010 VIA EFS WEB (EFS ID 8201379).

Remarks

All previous grounds for rejection have been obviated by the claim amendments submitted on July 21, 2010 as amended on August 8, 2010. At the risk of stating the obvious, the Assignee notes that the previous grounds for rejection have all been obviated because the now current set of claims all deal with the development and use of variables related to purchasing activity. The development and use of variables related to purchasing activity is not covered by the previously cited references and has not been the subject of any discussion of the instant applications' written description and/or claim language. Because the U.S.P.T.O. recently issued a patent to a large company for a similar development and use of variables related to purchasing (aka procurement) activity, the claim amendments should also traverse the non statutory subject matter and/or lack of utility objections that were previously included in the grounds for rejection. Finally, the information from co-pending applications provided herein makes it even more clear that all claim rejections are moot as it provides clear documentation that the Examiner and the organization do not appear to have the level of skill in the art required to: interpret claims as required to assess 35 U.S.C. 101 compliance, evaluate prior art as required for a 35 U.S.C. 103 evaluation and/or evaluate a written description under either paragraph 1 or 2 of 35 U.S.C. 112.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability.

Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for

“inventions” that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an “invention” that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application.
- 2) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter. This is clearly the case in the instant application.
- 3) the apparently improper use of Official Notice.
- 4) the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are “too subjective” and/or not enabled. This is clearly the case in the instant application, see for example Patent 7,251,582.
- 5) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 10/750,792 was U.S. Patent 6,012,053 (hereinafter, Pant). Pant describes a mechanism through which results from a search query are ranked according to user specified relevance factors to allow the user to control how the search results are presented. In particular, the Pant invention provides the user with the ability to assign weights to different attributes of the search results, generate a score for each item in the results using said weights and then present results ranked according to the score. A comparison on the key features of Pant to the features of the invention claimed in co-pending application 10/750,792 and the features of the invention claimed in U.S. Patents 7,212,996 and 7,433,840 shows that Pant appears to be a much closer match to the issued patents than it is to the rejected claims in the instant application.

Feature	Pant	7,212,996 & 7,433,840	10/750,792
Primary application	Results from a search query are ranked according to user specified relevance factors	A search application that allows the user to enter a set of criteria of their choice with desired ranges and a weighting factor to be applied to the criteria	Identify impact and value of keywords
User defined relevance factors?	Yes	Yes, user defined criteria	No
User defined weightings?	Yes	Yes	No
Score based on factors and weightings used to sort results?	Yes	Yes	No
Keyword financial impact?	No	No	Yes
Keyword valuation?	No	No	Yes

The Examiner for the instant application was an Examiner for the two issued patents and is currently the Examiner for application 10/750,792. Although Pant is well known to those of average skill in the art, the Examiner did not cite Pant during the prosecution of the two issued patents but he did cite it during the prosecution of application 10/750,792. In fact, the Examiner cited Pant in an Office Action for application 10/750,792 on June 17, 2008 and references were still being considered for the application that matured into Patent 7,433,840 on August 15, 2008.

6) the need to traverse rejections made for informalities.

7) the need to overcome actions taken by Examiners in apparent violation of one or more statutes, rules or established precedents. These actions appear to be concentrated in Asset Trust applications with pending claims that appear to be similar to those in *prima facie* invalid patents previously issued to one or more large companies.

For example, the first written description rejection for the instant application was in the second Office Action for the instant application which had pending claims similar to those in a *prima facie* invalid patent that had been issued to a large company. The written description rejection was apparently made without evidence (in place of the requisite preponderance of evidence) by an Examiner who does not appear to have the requisite level

of skill in the relevant arts after a request to amend the claims in the instant application to be more distinct from the language contained in the claims of the prima facie invalid patent was refused. Two of the other written description rejections received by Asset Trust were apparently made without evidence by the same Examiner (who does not appear to have the requisite level of skill in the relevant arts) for applications with claims similar to those in prima facie invalid patents issued to the same large company. Other written description rejections appear to follow this pattern.

The U.S.P.T.O. has issued a number of prima facie invalid patents for the use of xml in data management. The Examiner for an Asset Trust application for an invention that used xml in data management recently imposed a restriction requirement in a final rejection in apparent violation of 37 CFR 1.142. The improper application of this requirement appeared to be an effort to avoid the examination and/or the appeal of claims related to the use of xml in data management that would have made the prima facie invalidity of the issued xml data management patents more obvious. The Examiner for another Asset Trust application imposed a restriction requirement in a final rejection in apparent violation of 37 CFR 1.142 in what appeared to be a similar effort to avoid examination and/or the appeal of claims that would have made the prima facie invalidity of a patent for risk mitigation optimization more obvious.

In the case of the instant application, the Examiner and the BPAI have to date refused to re-open prosecution in spite of the fact that the Assignee has twice complied the requirements for having prosecution re-opened (the payment of the fee and the provision of an explanation in accordance with the meaning of 37 CFR 1.111 – see MPEP 706.07(h)). As in the other cases outlined above, the apparent violation of the rules appears to be related to the fact that the claims in the (re-opened) Asset Trust application are now similar to those in a prima facie invalid patent that was previously issued to a large company.

It is not clear why one or more statutes, rules or established precedents have apparently been violated during the prosecution of Asset Trust patent applications. However, it is clear that any assertion that Asset Trust applications are being examined fairly and/or in accordance with the law is disingenuous at best.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of the instant application.

- Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the Examiner, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Request for Correction

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent application bears no resemblance to the patent application examination standards dictated by statute and precedent. Among other things this has resulted in the allowance and issue of dozens of apparently invalid patents. Prompt correction is requested.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President

Date: August 11, 2010